

Group I: Claims 107-110, 112-117, 119-121, 123-125 and 131-136 drawn to a filter, a filter house and method of producing a filter.

Group II: Claims 127-130, drawn to a method for utilizing a filter.

In addition, the Examiner has required Applicant to elect one of the disclosed species for prosecution on the merits.

Applicant elects to prosecute the invention of Group I, claims 107-110, 112-117, 119-121, 123-125 and 131-136 drawn to a filter, a filter house and method of producing a filter. Applicant makes this election WITH TRAVERSE and respectfully requests withdrawal of the restriction requirement, or in the alternative, modification of the restriction requirement to include the prosecution of Group II as a unified invention, for the reasons provided as follows in relevant part.

Applicant has previously received:

- A first Office Action dated 27 October 2008, which stated that the claims directed towards the filter (independent claim 102), the filter house (independent claim 122) as well as use of the filter (independent claim 127) were anticipated by Hunter et al. (US 2,537,898). The method of producing a filter (independent claim 126) was restricted out.
- A second Office Action dated 3 April 2009, which stated that the claims directed towards the filter (now independent claim 131), the filter house (now independent claim 135) as well as a method of producing a filter (independent claim 136) were anticipated by Hunter et al. (US 2,537,897). The method of producing a cylindrical filter (independent claim 137) was withdrawn from consideration as being directed to a

non-elected invention. Claim 127 were rejected as the claim did not set forth any steps involved in the method.

A response was filed to both Office Actions explaining why the applicant believes the invention is novel. In both responses claims were filed with limited scope of protection, e.g. the independent claim directed to the filter was amended (now claim 131). In the response dated 29 June 2009 the claim directed to the filter was limited by the feature:

“a most upstream zone of spacer medium and/or filtration medium, where a most upstream filtration area of said upstream zone being with no barrier to liquid to be filtered,”

and the feature:

“bypass space upstream of said first sealing and/or upstream of said second sealing to allow liquid to exit and/or enter said edges of said first filtration medium and/or of said spacer medium”.

The Examiner has stated “The filter of group I does not contain a special technical feature as all of the limitations of group I are known in the art. Therefore, groups I and II do not have a common special technical feature.” However, the Examiner does not explain which document describes the limitations of claim 131 as filed 29 June 2009.

Furthermore, if the claims of group I contain features which are known in the art, this still does not automatically result in non-unity between inventions, as the PCT in respect of unity does not require novelty of the features.

Rule 13.1 PCT states:

“The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (“requirement of unity of invention”).”

Nothing in this Rule states that at least one feature needs to be novel.

And Rule 13.2 PCT states:

“Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.”

Again, nothing in this Rule states that at least one feature needs to be novel.

Furthermore, even though the Examiner states that “groups I and II do not have a common special technical feature”, claim 127 explicitly refers to claim 131 by the statement “obtaining a filter described in claim 131”, and thus all the features of the filter as described in claim 131 are in claim 127. Thus groups I and II do indeed have a common special technical feature.

Nothing in Rule 13.1 and 13.2 of the PCT states that unity is based on novel features or on novelty of the inventions. Rather Rule 13.2 states “The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” Hereby known features can be arranged in a novel matter and indeed define a contribution over the prior art.

In addition, under 35 U.S.C. §121 “two or more independent and distinct inventions . . . in one Application may . . . be restricted to one of the inventions.” Inventions are “independent” if “there is no disclosed relationship between the two or more subjects disclosed” (MPEP 802.01). The term “distinct” means that “two or more subjects as disclosed are related . . . but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER” (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification;
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, “[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions” (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicant respectfully submits that Groups I and II designated by the Examiner fail to define a filter, a filter house, a method of producing a filter and a method for utilizing a filter with properties, structure or steps so distinct as to warrant separate examination and search. In addition, the Examiner has failed to state which different classifications would have to be searched. With regard to the criteria detailed in MPEP 808.02, Applicant submits that none of the three criteria are satisfied and that searching for these two species does not present a burden on the Examiner beyond that required for searching any one of the Groups I and II. Thus,

Applicant submits that the search and examination of Groups I and II can be made without serious burden, and therefore the Examiner must examine these claims of the application on the merits.

The Examiner's assertion to the contrary notwithstanding, Applicant respectfully submits that conjoint examination and inclusion of all the claims of the present application relating to Groups I and II would not present an undue burden on the Examiner, and accordingly, examination of all the claims as submitted is believed to be in order.

Summary

Applicant elects WITH TRAVERSE Group I. Applicant also requests that the election requirement be withdrawn, or in the alternative, the election requirement be modified to include Group II.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 07-1180.

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Respectfully submitted,

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